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[REDACTED] EXAMINER

STODOLA, DANIEL P

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3634

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/376,461	Applicant(s) Rillie
Examiner Daniel P. Stodola	Art Unit 3634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Apr 17, 2003.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-4 and 6-15 is/are pending in the application.

4a) Of the above, claim(s) 10-15 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4 and 6-9 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

The request filed on April 17, 2003 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application Serial No. 09/376,461 is acknowledged and a CPA has been established. In this regard, it should be noted that a continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53(d). Though applicant failed to check the appropriate box on the CPA request form, the instant request is interpreted to be a request for a continuation CPA. An action on the CPA follows.

#### ***Election/Restriction***

Claims 10-15 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 2 and affirmed in Paper No. 3.

#### ***Specification***

The specification is once again objected to for the reasons previously advanced on page 10, first paragraph, of the previous Office action, Paper No. 13, which are fully incorporated by reference thereto.

With respect to applicant's remarks beginning on page 3 of the amendment, it should first be noted that the instant examiner will not speculate as to the reasoning behind the actions or

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inactions of other examiners. Second, the actions/inactions of others are not germane to the issue at hand. In this regard, applicant should note the adage that “two wrongs do not make a right”.

Third, petition decisions, in general, from one Technology Center have no bearing on the practices of another Technology Center. Each petition is decided on the merits of each individual situation. Moreover, it appears that the decision that applicant refers to is not even on point with or even addresses the issue at hand raised by the examiner.

As previously specifically pointed out, applicant fails to provide a proper “incorporation by reference” of subject matter. MPEP 608.01(p) is explicitly clear on the requirements for a proper incorporation by reference of subject matter. The language in question being “boilerplate” is no excuse or justification for not properly identifying the referenced patent, application or publication. Any incorporation by reference of subject matter must include identification of the document possessing the material being incorporated. If no particular subject matter is being referred to, then it cannot be “incorporated by reference” into the instant specification.

With respect to the numerous other “boilerplate” sentences found on page 8 of the specification, it is pointed out that applicant’s statements have no bearing on the examiner’s obligation to apply the laws as required by patent examining procedures and controlling case law, even when such statements conflict with the controlling case law.

Appropriate correction is required.

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***New Matter Objections***

The amendment filed April 17, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the subject matter of U.S. Patent No. 6,035,593 that was incorporated by reference thereto. For example, the subject matter illustrated by Figs. 2-6 of U.S. Patent No. 6,035,593, including the support ring 38 and its attachment, dress ring 66, diffuser assembly 26, spring clips 72, lower support ring 68, seal 110, etc. Parent Application Serial No. 09/376,461 does not contain any of this disclosure from U.S. Patent No. 6,035,593 and, in fact, the desired incorporation by reference changes the invention originally disclosed by introducing a new concept that was not previously present.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 103***

At the outset, it should be noted that under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. Claims 1-4 recite that the flashing is "seamless". The "seamless" feature was first disclosed and described in the instant application. Claims 6-9 recite "at least one strengthening anomaly" for the skirt. The "strengthening anomaly" feature was first disclosed and described in

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the instant application. Neither of these features were disclosed or described in U.S. Patent No. 6,035,593. Accordingly, claims 1-4 and 6-9 are only entitled to the August 18, 1999 original filing date of the instant invention.

With respect to U.S. Patent No. 5,896,713 (Chao et al), it is noted that this patent was published April 27, 1999. The publication date of this patent is prior to the filing date of the instant application. The instant application has a different inventive entity than U.S. Patent No. 5,896,713. Accordingly, this patent is available as prior art under 35 U.S.C. 102(a).

In view of the fact that Chao et al are available under 35 U.S.C. 102(a), the exclusion under 35 U.S.C. 103(c) is not available and does not apply.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Nagler et al as advanced in the previous Office action, Paper No. 13.

Claims 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Nagler et al as applied to claim 1 above, and further in view of Deutsch as advanced in the previous Office action, Paper No. 13.

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Claims 1, 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Deutsch as advanced in the previous Office action, Paper No. 13.

Claims 1, 2, 4, 6, and 8 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsch in view of Chao et al as advanced in the previous Office action, Paper No. 13.

Claims 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Deutsch as applied to claims 1, 2, 4, 6, and 8 above, and further in view of Clark et al as advanced in the previous Office action, Paper No. 13.

Claims 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsch in view of Chao et al as applied to claims 1, 2, 4, 6, and 8 above, and further in view of Clark et al as advanced in the previous Office action, Paper No. 13.

#### *Response to Arguments*

Applicant's arguments filed April 17, 2003 have been fully considered but they are not persuasive.

Applicant's allegations with respect to Nagler et al and Deutsch appear to imply no skill on the part of the hypothetical "one of ordinary skill". However, this is not the legal standard. In particular, the law presumes skill, and not a lack thereof, on the part of one of ordinary skill in the art. See *In re Sovish*, 226 USPQ 771 (CAFC 1985).

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Further with respect to Nagler et al, applicant states that “nowhere does Nagler et al mention the word ‘skylight’” and then alleges that one skilled in the skylight art would not know to look in the roof mounted pipe art for ideas. Applicant’s arguments notwithstanding, flashing is flashing irrespective of what additional component it is used with. The function of the flashing remains the same whether used with a pipe vent or a skylight tube. Moreover, one of ordinary skill in the art would have routinely turned to the flashing art for solutions to problems occurring with the flashing. It is further noted that applicant has failed to present any reasoning or factual evidence to support the allegation that the two art areas are non-analogous. Attorney argument and self-serving conclusory statements cannot take the place of factual evidence.

Nevertheless, the law is well-settled and explicitly clear as to what constitutes analogous prior art. The law attributes to the hypothetical “one of ordinary skill in the art” knowledge of all prior art in the field of applicant’s endeavor and knowledge of prior art solutions for a common problem, even if outside that field. Accordingly, a reference is considered to be analogous prior art if it is within the field of applicant’s endeavor or is reasonably pertinent to the problem being solved. For example, see *In re Wood et al*, 202 USPQ 171 (CCPA 1979).

With respect to applicant’s field of endeavor, a review of the specification reveals that the field of invention is stated to be related “generally to tubular skylights, and more particularly to roof-mounted flashings” (emphasis added). See new page 1, lines 5-6, appearing under the heading “FIELD OF THE INVENTION”. The abstract of Nagler et al begins with “(a) roof mountable pipe flashing unit”. Further, Col. 1, lines 2-3, of Nagler et al state that their invention

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"relates generally to flashing units for roofs". Thus, it would appear that the roof-mounted flashing of Nagler et al is within the same field of endeavor as applicant's invention as originally defined by applicant, himself.

Assuming arguendo that applicant's statement that his field of invention was related particularly to roof-mounted flashings is to be interpreted to mean any roof-mounted flashings except those not used specifically with a tubular skylight, then one must determine whether or not Nagler et al are reasonably pertinent to the problem being solved. In this regard, it is noted that the first paragraph of page 2 describes the prior art flashing as being a multi-piece construction with the pieces being welded or otherwise fastened together. Problems resulting from the use of multiple pieces are defined as unsightliness of the seams, the possibility of failure of the seams, and the seams being an entry point for undesirable particles. It is further noted, though left unsaid by applicant, that the purpose of flashing in the first place is to provide weatherproof integrity to a roof at locations of roof penetration, such as would be caused by the tubular skylight. Nevertheless, Nagler et al disclose and teach the provision of flashing around roof penetrations to seal a roof penetration and restore the weatherproof integrity of the roof at that location and to utilize seamless flashing to minimize the hazard of leakage. Clearly, the provision of a flashing that is "seamless" for the purpose of minimizing the hazard of leakage is reasonably pertinent to the problem of seam failure, especially since doing away with the seam would avoid its failure which would then preclude leakage through the failed seam.

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Nagler et al have been found to constitute analogous prior art under the well-established two-pronged test for analogous prior art.

Further with respect to the Section 103 rejections involving Nagler et al, applicant should note that a *prima facie* case of obviousness is established when the teachings of the applied prior art references would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 189 USPQ 143 (CCPA 1976) and *In re Lalu*, 223 USPQ 1257 (CAFC 1984). Moreover, the test for obviousness is what the combined teachings of the references would have fairly suggested to those of ordinary skill in the art (*In re Keller*, 208 USPQ 871 (CCPA 1981)) and the references are evaluated to take into account not only the specific teachings of the references, but also the inferences that one of ordinary skill would have been expected to draw therefrom (*In re Preda*, 159 USPQ 342 (CCPA 1968)). Furthermore, there is no requirement that the references be combined for the exact same reasons as applicant as long as the prior art as a whole provides some suggestion to combine. For example, see *In re Beattie*, 24 USPQ2d 1040 (CAFC 1992). The fact that applicant may have recognized some other advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise have been obvious. See *Ex parte Obiaya*, 227 USPQ 58 (BPAI 1985).

Applicant's reference to and apparent reliance on MPEP 2144.03 is misplaced in view of the fact that no "official notice" positions have been advanced by the examiner.

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With respect to applicant's remarks concerning Chao et al in context with Nagler et al, as has been pointed out above, motivation for combining the teachings of the various references need not be explicitly found in the references themselves, *In re Keller*, supra.

It remains the examiner's position that a *prima facie* case for the obviousness rejections involving Nagler et al has been properly established. Applicant's arguments appear to be no more than a very general denial of the propriety of these rejections and are not convincing that the rejections are in error.

With respect to Deutsch, applicant alleges that "nowhere does this reference motivate or suggest use of its flashing with anything other than a roof aperture" and "(h)ow it might be combined with a skylight tube assembly is a mystery".

Contrary to applicant's first statement, the abstract of Deutsch clearly states that the flashing has "particular application for skylight installations". See line 1 of the abstract. Further, page 1, lines 5-6, state "(t)his invention has particular application to roof aperture flashing assemblies *for skylights* and the like" (emphasis added). The specification of Deutsch then goes on to discuss the use of the flashing in a skylight application. Accordingly, the point applicant was apparently attempting to make is not evident to the examiner. Is applicant alleging that his skylight assembly has no aperture through the roof? Is applicant alleging that his flashing is used someplace other than around the roof aperture? This can hardly be the case. Applicant is requested to clarify what the gist of the argument being represented by this statement is supposed to be.

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With respect to the second statement, it is unclear as to why it would be a “mystery” to anyone of ordinary skill in the art as to how to combine the teachings of Deutsch for a seamless flashing with Chao et al. Chao et al already provide clear teaching of where and how to use a flashing with a tubular skylight assembly and Deutsch teaches making a flashing seamless. How is it readily understood where and how to use a flashing when it was constructed of multiple pieces, but, as soon as it is constructed as a seamless one-piece element, it is a complete “mystery” as to how or where it would be used? Applicant fails to provide any basis/rationale to support this allegation.

If applicant’s “mystery” comment was intended to allege some sort of “bodily incorporation” requirement, then applicant should note that the law is clear that there is no requirement for the bodily incorporation of the features of one reference into another. Rather, the test for combining references is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See *In re Keller*, supra. Here, Chao et al disclose a tubular skylight assembly having a metal flashing, transparent dome, and at least one skylight tube. Deutsch’s disclosure of a *seamless* metal flashing for skylight applications would have furnished one of ordinary skill in the art with ample suggestion to provide the metal flashing of Chao et al *seamless*. As so modified, the Chao et al assembly would meet all of the limitations of the claim(s). Thus, the examiner fails to see any “mystery” arising from this modification.

With respect to applicant’s remarks concerning Clark et al, it should be noted that Clark et al have been applied as evidence that the provision of strengthening ribs in flat metal sheets is old

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and well-known per se. The fact that the evidence of this teaching happens to be in the context of a sewer manhole application is of little consequence to the teaching of the use of strengthening ribs. In particular, one of ordinary skill would have turned to known metal formation techniques, not sewers or sewer covers, to solve a problem of warping or inadequate strength for a given thickness of a flat metal sheet. Further, it is noted that applicant's remarks fail to address the examiner's rationale that was clearly and specifically advanced in the rejection of record. The rejection is clear that it is the knowledge of rib formation per se that is being relied upon and that Clark et al were applied as evidence of such knowledge.

With respect to applicant's comments regarding the reopening of prosecution, it is once again pointed out that the procedure for reopening prosecution after a Board decision was fully complied with and authorized as required per MPEP 1214.04. However, the examiner wishes to point out that examining procedure is quite clear that full faith and credit to the prior examiner's search is to be given *unless there is clear error in the previous action or knowledge of other prior art*. See MPEP 704.01. Note that this is also the policy even when claims were previously allowed. See MPEP 706.04. The claims in the instant application have never been allowed or otherwise indicated to be allowable.

Further in this regard, applicant should note the paragraph of MPEP 1214.04 immediately following the quoted paragraph provided by applicant. This paragraph provides clear authority for prosecution to be reopened after a Board decision. It should also be noted that the paragraph quoted by applicant refers to a "challenge to make a new search", it does not prohibit "searching"

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to retrieve the “other prior art” that the examiner had knowledge existed. In any event, if the claimed subject matter is unpatentable, applicant is not entitled to it under any circumstances.

The inclusion of a declaration under Rule 132 (sic, Rule 131) is acknowledged. However, it should be noted that the showing provided does not overcome the November 13, 1997 effective date of Chao et al. Note 37 CFR 1.131(a). Thus, prior invention has not been shown and Chao et al have not been removed as valid prior art under 35 U.S.C. 102(a).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stodola whose telephone number is 703-308-2686.

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The fax phone number for the organization where this application or proceeding is assigned is 703-305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

STODOLA  
May 12, 2003



DANIEL P. STODOLA  
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